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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/046,257

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Mutsumi Matsumoto

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12/14/2006

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EXAMINER

GART, MATTHEW S

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 12/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/046,257

Applicant(s)

MATSUMOTO, MUTSUMI

Examiner

Matthew S. Gart

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,4,7,9 and 12-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4,7,9 and 12-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Prosecution History Summary***

- Claims 2-3, 5-6, 8 and 10-11 were cancelled.
- Claim 15 was added.
- Claims 1, 4, 7, 9 and 12-14 were amended via the applicant's response filed on 10/23/2006.
- Claims 1, 4, 7, 9, 12-15 are pending in the instant application.

***Claim Objections***

**Claims 1 and 4 are objected to because of the following informalities:**

Claim 1 recites, receiving information for a request to confirm reception of delivery goods entered by a deliverer when a recipient of the delivery goods from the location is sent, wherein the information includes a message requesting the recipient to confirm as to whether the recipient approves or rejects delivery of the goods by the deliverer to the location.

This appears to be a typographical error, and the Examiner believes the applicant meant to recite, receiving information for a request to confirm reception of delivery goods entered by a deliverer when a recipient of the delivery goods from the location is absent, wherein the information includes a message requesting the recipient to confirm as to whether the recipient approves or rejects delivery of the goods by the deliverer to the location

Appropriate correction is required.

**Claim 13 is objected to because of the following informalities:**

Claim 13 recites, receiving information for a request to confirm reception of delivery goods entered by a deliverer when a recipient of the delivery goods from the location is sent, wherein the information includes a message requesting the recipient to confirm as to whether the recipient approves or rejects delivery of the goods by the deliverer to the location:

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This appears to be a typographical error, and the Examiner believes the applicant meant to recite, receiving information for a request to confirm reception of delivery goods entered by a deliverer when a recipient of the delivery goods from the location is absent, wherein the information includes a message requesting the recipient to confirm as to whether the recipient approves or rejects delivery of the goods by the deliverer to the location

Appropriate correction is required.

**Claim 14 is objected to because of the following informalities:**

Claim 14 recites, receiving information for a request to confirm reception of delivery goods entered by a deliverer when a recipient of the delivery goods from the location is sent, wherein the information includes a message requesting the recipient to confirm as to whether the recipient approves or rejects delivery of the goods by the deliverer to the location.

This appears to be a typographical error, and the Examiner believes the applicant meant to recite, receiving information for a request to confirm reception of delivery goods entered by a deliverer when a recipient of the delivery goods from the location is absent, wherein the information includes a message requesting the recipient to confirm as to whether the recipient approves or rejects delivery of the goods by the deliverer to the location

Appropriate correction is required.

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***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 1, 4, 13 and 14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

For a claimed invention to be statutory, the claimed invention must produce a useful, tangible and concrete result. An invention which is eligible for patenting under 35 U.S.C 101, is in the "useful arts" when it is a machine, manufacture, process or composition of matter, which produces a useful, concrete and tangible result. The fundamental test for patent eligibility is thus to determine whether the claimed invention produces a useful tangible and concrete result. See *AT&T v. Excel Communications Inc.*, 172 F.3d at 1358, 50 USPQ 2d at 1452 and *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d at 1373, 47 USPQ 2d at 1601 (Fed. Cir. 1998). The test for practical application as applied by the examiner involves the determination of the following factors.

a)"useful" - The Supreme Court in *Diamond v. Diehr* requires that the examiner look at the claimed invention as a whole and compare any asserted utility with the claimed invention to determine whether the asserted utility is accomplished. Applying utility case law the examiner will not that:

i. utility need not be expressly recited in the claims, rather it may be inferred.

ii. if the utility is not asserted in the written description, then it must be well established.

b) "tangible" - Applying *In re Warmerdam*, 33 F.3d 1354, 31 UAPQ 2d 1754 Fed. Cir. 1994), the examiner will determine whether there is simply a mathematical construct claimed, such as a disembodied data structure and method of making it. If so, the claim involves no more than manipulation of an abstract idea and is, therefore, nonstatutory under 35 U.S.C 101. In *Warmerdam*, the abstract idea of a data structure became capable of producing a useful result when it was fixed in a tangible medium, which enabled its functionality to be realized.

c) "concrete" - Another consideration is whether the invention produces a "concrete" result. Usually, this question arises when a result cannot be assured. An appropriate rejection under 35 U.S.C 101 should be accompanied by a lack of enablement rejection, because the invention cannot operate as intended without undue experimentation.

In the present case, the claims 1, 4, 13 and 14 sets forth a final step of notifying said deliverer, but the mere provision of a notification, absent any active involvement of said notification in an executed step, does not move to manifest a useful result.

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**Claims 9 and 12 are rejected under 35 U.S.C. 101 as being directed towards non-statutory subject matter.**

Claims 9 and 12 require a computer readable store medium, which stores a program. The specification does not set forth what constitutes a computer readable medium, and therefore said medium could be directed towards a propagated carrier signal. Claims that recite nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, per se, and as such are nonstatutory natural phenomena. O'Reilly, 56 U.S. (15 How.) at 112-14. Moreover, it does not appear that a claim reciting a signal encoded with functional descriptive material falls within any of the categories of patentable subject matter set forth in §101.



### **Claim Rejections - 35 USC § 112**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 1 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

The Examiner notes, the “further storing information” step of claim 1 is indefinite. It is unclear who is receiving the delivery goods identification information and reception approval/refusal information entered by said recipient. The language of the claim is such that a person of ordinary skill in the art could not interpret the metes and bounds of the claim so as to understand how to avoid infringement.

The Examiner notes, the “receiving information” step of claim 1 is indefinite. It is unclear whom or what is receiving the information. The language of the claim is such that a person of ordinary skill in the art could not interpret the metes and bounds of the claim so as to understand how to avoid infringement.

The Examiner further notes, claim 1 recites the limitation “the confirmation request information.” There is insufficient antecedent basis for this limitation in the claim.

**Claims 1 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01.**

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The omitted steps are: a storing step previous to the extracting recipient information step. It is unclear how and where information can be extracted from if it is not stored.

**Claims 7 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

The Examiner notes, claim 7 recites "a unit which receives information for the confirmation request..." It is unclear if this is the same information stored in the storage unit. The language of the claim is such that a person of ordinary skill in the art could not interpret the metes and bounds of the claim so as to understand how to avoid infringement.

**Claims 9 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

The Examiner notes, the "further storing information" step of claim 1 is indefinite. It is unclear who is receiving the delivery goods identification information and reception approval/refusal information entered by said recipient. The language of the claim is such that a person of ordinary skill in the art could not interpret the metes and bounds of the claim so as to understand how to avoid infringement.

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The Examiner notes, the "receiving information" step of claim 9 is indefinite. It is unclear whom or what is receiving the information. The language of the claim is such that a person of ordinary skill in the art could not interpret the metes and bounds of the claim so as to understand how to avoid infringement.

The Examiner further notes, claim 9 recites the limitation "the confirmation request information." There is insufficient antecedent basis for this limitation in the claim.

**Claims 9 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01.**

The omitted steps are: a storing step previous to the extracting recipient information step. It is unclear how and where information can be extracted from if it is not stored.

**Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

The Examiner notes, the "further storing information" step of claim 13 is indefinite. It is unclear who is receiving the delivery goods identification information and reception approval/refusal information entered by said recipient. The language of the

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claim is such that a person of ordinary skill in the art could not interpret the metes and bounds of the claim so as to understand how to avoid infringement.

The Examiner notes, the "receiving information" step of claim 13 is indefinite. It is unclear whom or what is receiving the information. The language of the claim is such that a person of ordinary skill in the art could not interpret the metes and bounds of the claim so as to understand how to avoid infringement.

The Examiner further notes, claim 13 recites the limitation "the confirmation request information." There is insufficient antecedent basis for this limitation in the claim.

**Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01.**

The omitted steps are: a storing step previous to the extracting recipient information step. It is unclear how and where information can be extracted from if it is not stored.

**Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

The Examiner notes, the "further storing information" step of claim 1 is indefinite. It is unclear who is receiving the delivery goods identification information and reception

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approval/refusal information entered by said recipient. The language of the claim is such that a person of ordinary skill in the art could not interpret the metes and bounds of the claim so as to understand how to avoid infringement.

The Examiner notes, the "receiving information" step of claim 14 is indefinite. It is unclear whom or what is receiving the information. The language of the claim is such that a person of ordinary skill in the art could not interpret the metes and bounds of the claim so as to understand how to avoid infringement.

The Examiner further notes, claim 1 recites the limitation "the recipient request information." There is insufficient antecedent basis for this limitation in the claim.

**Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01.**

The omitted steps are: a storing step previous to the extracting recipient information step. It is unclear how and where information can be extracted from if it is not stored.

### ***Response to Arguments***

Applicant's arguments filed 4/05/2006 have been fully considered but they are not persuasive.

The rejection of the pending claims as being anticipated by Moreno (U.S. Patent Publication No. 2002/00355152) has been vacated. Moreno claims priority to provisional application 60/218,400 filed on July 14, 2000. Said provisional application does not provide 35 U.S.C. 112, first paragraph support for paragraphs 0082 - 0112 of the Moreno reference, therefore those sections of Moreno do not qualify as prior art.

### ***Examiner's Comments***

The sections of Moreno which qualify as prior art do not expressly teach remotely notifying a recipient, wherein said notification includes a message requesting the recipient to remotely confirm as to whether the recipient approves or rejects delivery of delivered goods. None of the prior art of record remedies these deficiencies.

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***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

"ShopperBox Networks Launches E-Commerce Delivery Solution," PR Newswire, New York, August 1, 2000, pg. 1

WO 01/08078 A1, International Publication Date: 1 February 2001, discloses a delivery system secured storage container method.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew S. Gart whose telephone number is 571-272-3955. The examiner can normally be reached on M-F, 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MSG  
Primary Examiner  
December 8, 2006

  
MATTHEW S. GART  
PRIMARY EXAMINER  
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